

## REMARKS

This is a request for reconsideration filed under 37 C.F.R. 1.116. No changes have been made in the specification and claims of the above-identified U.S. Patent Application.

### I. OBVIOUSNESS REJECTION

Claims 1 to 16 were rejected under 35 U.S.C. 103 (a) as obvious over I. Mitra, et al, (U.S. Patent 6,525,300), in view of Krause, et al.

**1. I. Mitra, et al, is not a Prior Art Reference that can be used alone or together with other prior art references to reject claims of the above-identified application under 35 U.S.C. 103**

U.S. Patent 6,525,300 issued to I. Mitra, et al, on February 25, 2003, but the U.S. filing date of the above-identified application is November 8, 2001, which is over a year earlier. Thus I. Mitra, et al, would be a prior art reference based on 35 U.S.C. 102 (e) because of its earlier U.S. effective filing date, namely July 30, 1999.

However I. Mitra, et al, thus falls under the exception according to paragraph (c) of 35 U.S.C. 103, which reads as follows:

(c) Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of **section 102** of this title, shall **not** preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, *owned by the same person or subject to an obligation of assignment to the same person*. [Emphasized portions ours].

**I. Mitra, et al, and the above-identified U.S. Patent application are commonly owned by Schott Glas.** The assignee listed on the front cover of I. Mitra, et al, is Schott Glas. The assignment that assigns the above-identified application to Schott Glas has been recorded in the U.S. Patent and Trademark Office at reel/frame 012616/0972. Consulting these records will show that the above-identified U.S. Patent Application is indeed assigned to the Schott Glas. Thus the present application and I, Mitra, et al, are commonly owned.

For the following reasons the above rejection under 35 U.S.C. 103 should be withdrawn, because the subject matter of I, Mitra, et al, and the present application are commonly owned and because and because I. Mitra is only prior art under subsection (e) of 35 U.S.C. 102.

## **2. European Search Report**

The European Search report for EP 01 124 749 was filed in the U.S. Patent Office with an Information Disclosure Statement dated December 3, 2003. The European Search report only listed "A" references. The search at the European Patent Office found that none of the references could be used alone or together with other references to reject the claimed invention. The search results included the Krause reference.

### **3. The Features of the Claimed Invention**

For convenience of examination the following is the currently pending main claim (from the amendment filed December 5, 2003):

**1. A cooking unit with a glass-ceramic panel (1), said glass-ceramic panel consisting of transparent colorless glass-ceramic material, or a glass panel, said glass panel consisting of pre-stressed transparent colorless glass material, said glass-ceramic panel or said glass panel providing a cooking surface of the cooking unit and said cooking surface having cooking zones heated with respective radiant heating elements (3), wherein said glass-ceramic panel or said glass panel has an upper side provided with a full surface decorative coating (7) and a solid colored or plain colored IR permeable coating (6) on an underside of said glass-ceramic panel or said glass panel.**

Applicants' claim 1 claims a cooking unit with a glass-ceramic or a glass panel. The features of the claimed invention are the following (see e.g. amendment dated 12/5/2003):

- (1) the glass-ceramic panel itself is transparent and colorless;
- (2) a full surface decorative coating is provided on a top side of the panel;
- (3) a solid or plain colored IR permeable coating is provided on the underside of the panel; and
- (4) a cooking surface divided into cooking zones heated with radiant heating elements.

The dependent claims claim embodiments of the cooking unit limited e.g. to various specific features of the coatings including temperature resistance properties of the paints used to provide the coatings and their chemical

compositions.

Summarizing, the advantages of the special combination of features 1 to 4 are: first, the glass-ceramic panel is not made from a very expensive colored glass melt, but instead from a colorless glass melt. The use of coatings on the top and bottom of the glass-ceramic panel provides great flexibility in selection of color impressions produced by the coatings, so that the conspicuousness of dirt or similar marks, such as fingerprints, on the top surface of the cooking panel is reduced. Claim 2 limits the color impression to white, creamy white and bisque, the latter color impressions making usage marks and dirt less conspicuous. Furthermore the top of full surface decorative coating protects the glass-ceramic panel from scratches, metal abrasion and usage marks.

The claimed subject matter of claim 1 is distinguished from the art because it provides a full surface colored decorative coating on the upper side of the panel and a single colored IR permeable coating on the underside of the panel to obtain a predetermined desirable color pattern. Previously in the art this could only be done by providing a colored glass melt from which the panel is made, which is comparatively expensive. The invention provides greater flexibility in design choice of colors and the like.

#### **4. Relationship of the Subject Matter of Claim 1 to Mitra and Krause**

1. Mitra, et al, disclose a glass frit with a special composition which can be mixed with pigment to obtain a "glass color" for colored decorations (column 8, lines 3 to 11, and lines 60 to 83).

These colored decorations can be "full surface decorations", but also "sparse decorations" (column 9, lines 41 to 44) and they are provided on the upper side of the panel. Their purpose is to provide "low abrasion susceptibility" (column 9, line 40). However the known decorated panels of I. Mitra, et al, are not made of transparent colorless glass or glass-ceramic material. As described on page 2 of the specification of the above-identified application for aesthetic reasons cooking panels are required to block observation of the operating parts of the cooking unit under the cooking panels from a point above the cooking panels. Thus the known glass or glass-ceramic panel of I. Mitra, et al, is colored and is not transparent; otherwise it would not block observation of the parts underneath it in the case of a "sparse decoration", i.e. a coating on the top of the panel that is not full surface and only covers parts of the top surface.

I. Mitra, et al, do not teach or suggest the limitations that the glass or glass-ceramic substrate for their coatings should be colorless and transparent. I. Mitra, et al, do not disclose or suggest that the observation of the parts below the panel is blocked by a uniformly colored coating on an underside of the panel.

I. Mitra, et al, only suggest a glass or glass-ceramic panel colored in the conventional manner to block observation of the parts below it, which has a conventional colored decoration or markings on the upper side, which are not necessarily full surface.

Krause, et al, do disclose a glass or glass-ceramic panel that is colorless and transparent. However the main inventive feature of Krause, et al, is to provide a colored layer **only** on the underside of the panel which functions to

block observation of the parts under the transparent panel.

Krause, et al, expressly teaches that the upper side of the panel should be free of any decoration! See for example the last line of the abstract and also the last line of claim 1 of IDE 200 05 461 U1 ("decorfrei") or in the corresponding published U.S. Patent Application. This is teaching of the opposite from I. Mitra, et al, and the invention, as claimed in the applicants' claim 1.

According to MPEP.2145. X. D. 2. (and the court decision cited therein) a prior art reference that teaches away from a claimed combination cannot be combined with another reference under 35 U.S.C. 103 (a) to reject the claimed combination as obvious. Furthermore the Federal Circuit Court of Appeals has said:

"In determining whether such a suggestion [of obviousness] can fairly be gleaned from the prior art...It is indeed pertinent that these references teach against the present invention. Evidence that supports, rather than negates, patentability must be fairly considered." *In re Dow Chemical Co.*, 837 F.2nd 469,473, 5 U.S.P.Q.2d 1529, 1532 (Fed.Cir. 1988)

Not only does Krause teach away from providing a decorative coating on the top surface of the cooking panel, but Krause teaches the opposite; Krause states that the top surface, for the purposes and objects of his invention, must be decoration free. In Krause the decorative coating is provided on the underside, not the top side. Thus these two references cannot be combined under 35 U.S.C. 103 (a) to reject applicants' amended claim 1.

Thus Krause cannot be viewed as suggesting the modifications of the subject matter of I. Mitra, et al, to obtain the subject matter of applicants' claim 1

under 35 U.S.C. 103 (a), since Krause, et al, teaches the opposite from the claimed invention and I. Mitra, et al.

The motivation for the combination described on page 3 of the Office Action is not valid because there is no reason from the standpoint of heat resistance to provide a coating on the bottom side of a glass or glass-ceramic panel used to provide a cooking surface. Glass, which is pre-stressed according to claim 1, or glass-ceramic material has sufficient heat resistance so that it can withstand the heat from the radiant heating elements without a coating on its underside, at least at the temperatures used for units to cook food. See Rapp, et al, for example for a glass-ceramic article that can be used to provide a cooking surface, which does not have a bottom coating.

In summary, most significantly I. Mitra, is not a valid reference that can be used alone or together with other references to reject the claims of the above-identified U.S. Patent Application under 35 U.S.C. 103, because it is too late (so that it is a reference under 102 (e)) and it falls under the exception created by 35 U.S.C. 103 (c), since it and the above-identified U.S. Patent Application are commonly owned by Schott Glas. Perhaps that is part of the reason Mitra was not mentioned in the European Search Report.

For the following reasons withdrawal of the rejection of claims 1 to 16 under 35 U.S.C. 103 (a) over I. Mitra, et al, in view of Krause, et al, is respectfully requested.

## **II. INDEFINITENESS REJECTION**

Claims 1 to 16 were rejected under 35 U.S.C. 112, second paragraph, for indefiniteness.

The only reason given for this rejection was that it was not clear in claim 1 whether or not applicant claims a glass-ceramic panel or a glass panel.

Claim 1 claims a cooking unit. The cooking unit comprises either a glass-ceramic panel or a glass panel. According to claim 1, in other words, the cooking unit includes a transparent colorless panel, which is provided with the decorative coating on the top side and the IR permeable coating on the bottom side. However the transparent colorless panel can be made of glass or glass-ceramic material.

It is respectfully submitted that one skilled in the art would understand from the current wording of claim 1 that claim 1 claims a cooking unit with a transparent colorless panel with coatings on the top side and bottom side and that the panel can be made of glass or glass-ceramic material.

The use of "or" and the claiming of alternatives in a patent claim, such as claim 1, is acceptable according to MPEP 2173.05 (h) II. Furthermore glass material has some similarities to glass-ceramic material.

No reasons have been given for the rejection of any of the dependent claims as indefinite.

On the other hand, applicants would consider any specific suggestions for changes in the wording of claim 1 that would make the claim clearer and easier




to understand.

For the foregoing reasons withdrawal of the rejection of claims 1 to 16 under 35 U.S.C. 112, second paragraph, for indefiniteness is respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawing be further amended or corrected in formal respects to put this case in condition for final allowance, then it is requested that such amendments or corrections be carried out by Examiner's Amendment and the case passed to issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing the case to allowance, he or she is invited to telephone the undersigned at 1-631-549 4700.

In view of the foregoing, favorable allowance is respectfully solicited.

Respectfully submitted,



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